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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Yoram Cedar, Micky Holtzman and Yosi Pinto
Title: Multiple Removable Non-Volatile Memory Cards Serially Communicating With a Host
Application No.: 09/641,023 Filing Date: August 17, 2000
Examiner: Auve, Glenn Allen Group Art Unit: 2181
Docket No.: SNDK.158Us0 Conf. No.: 4831

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Mary E. Buggin
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Technology Center 2100

RESPONSE TO OFFICE ACTION

Sir:

This is in response to the non-final Office Action mailed December 4, 2003, in the above-identified application. No amendments are being made.

Reconsideration of the rejection of claims 1 – 20 and 24 – 32, all the claims in the present application, is respectfully requested on the basis of the further evidence being filed herewith and the following remarks. The additional evidence is a “Supplemental Declaration of Applicants Under 37 C.F.R. § 1.132.” Two identical copies of the Supplemental Declaration are being filed, one signed by one of the applicants and the other signed by the other two applicants. This Supplemental Declaration, with paragraphs 7 – 10, should be considered along with the original “Declaration of Applicants Under 37 C.F.R. § 132,” filed October 9, 2003, having paragraphs 1 – 6.

In response to the rejection of all claims under 35 U.S.C. 102(a) as anticipated by the SD Specification 1.0 submitted under the provisions of MPEP §724, applicants unequivocally state in paragraph 9 of the Supplemental Declaration that the portions of the SD Specification 1.0

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upon which the rejection is based as describing the claimed invention describe "subject matter conceived solely by us." This clearly satisfies the requirement of MPEP § 716.10, which states:

"An uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship."

In addition, the rejection under 35 U.S.C. 102(a) is believed to be improper since there has been no showing that the SD Specification 1.0 upon which the rejection is based was *publicly* known before applicants' invention. The terms "known or used" of the prior art definition of 35 U.S.C. 102(a) have been interpreted by the courts to mean "publicly" known or used. (See MPEP § 2132.) It has already been said that the SD Specification 1.0 was made available under confidence to companies joining the SDA (Original Declaration, ¶3). Indeed, a redacted version of this Specification was submitted to the USPTO in confidence under the provisions of MPEP § 724. Portions of the SD Specification 1.0 were made available to the public without restriction by a separate document (Original Declaration, ¶ 4) also submitted to the USPTO but the rejection is not based on that document. In any event, the applicants herein have been shown to be the originators of cited portions of the SD Specification 1.0.

The unequivocal statement regarding inventorship in paragraph 9 of the Supplemental Declaration is also believed to overcome the rejection under 35 U.S.C. § 102(f). Applicants have unequivocally stated that the portions of the SD Specification 1.0 relied upon in the Office Action as describing the claimed subject matter are descriptions of their invention.

The Interview Summary of examiner Glenn Auve that was mailed January 14, 2004, accurately summarizes telephone conversations had with the undersigned about this application on January 9, 12 and 13, except some additional explanation is need for the last point made in that summary. The suggestion that all portions of the SD Specification 1.0 describing the claimed subject matter or other original work of the applicants be described is believed burdensome and an unnecessary task. The techniques being claimed are not neatly described by themselves in separate sections of the document, contrary to what may be more common in other cases. Rather, they and their interaction with other portions of the memory system are described or referenced in many sections of the document. It is believed sufficient that the applicants have responded in their Supplemental Declaration concerning the sections of the SD Specification upon which the claims have been rejected in the Office Action.

To the extent that an identification of all portions of the document that describe original work of any of the applicants, even if not claimed, is being requested, this request is respectfully submitted to be totally irrelevant to any legitimate issue or factual question in this case. It is believed the added evidence being made of record by the Supplemental Declaration will satisfy the need perceived by the examiners' for additional information about the circumstances of the cited SD Specification 1.0.

The undersigned also spoke by telephone with special projects examiner Pinchus Laufer on January 14, 2004. The main topic of the telephone conversations with examiners Auve and Laufer was the adequacy of the original applicant Declaration, particularly its paragraph 6, to establish that the portions of the SD Specification 1.0 used to reject the claims are a description of applicants' invention. Paragraph 9 of the Supplemental Declaration being filed herewith supplements paragraph 6 in this regard, and directly references the rejection. In addition, as requested by the examiners, the Supplemental Declaration provides further explanations of how the subject matter described in the document was developed and the document written. In paragraph 10, Yosi Pinto declares that he was the principal writer of the SD Specification 1.0. It is believed that the concern of the examiners for a further explanation of how applicants' invention came to be described in the SD Specification 1.0 has been satisfied by the Supplemental Declaration being filed herewith.

Although this further declaration is being filed, it must be repeated that it is believed that the rejection of the claims for the lack of further information was in error. It is true that the declaration in the case of *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) included other information in addition to the unequivocal statement of inventorship but it is that statement that the court held to overcome the rejection, not the additional information included. As a result, this CCPA decision is cited by MPEP § 716.10 as authority for the USPTO policy of accepting such an unequivocal statement of inventorship to overcome such a rejection, also without mention of a need for any such additional information.

The only exception given in MPEP § 716.10 to the acceptance of an unequivocal statement of inventorship to overcome a reference describing the inventors' work is where there is some evidence that contradicts such a statement. No such contradictory evidence appears to have been asserted in either the Office Action or during the telephonic examiner interviews. The further evidence provided by the Supplemental Declaration answers the questions raised by the

examiners on account of the cited SD Specification 1.0 including contributions from other individuals at SanDisk, Toshiba and MEI. Although many individual contributions were made in the joint effort to develop specifications for the new Secure Digital (SD) memory card, those claimed in the present application are those of its applicants alone. Nothing in the present record contradicts the unequivocal statement of applicants that descriptions of the claimed subject matter in the cited SD Specification 1.0 are descriptions of inventions made solely by them.

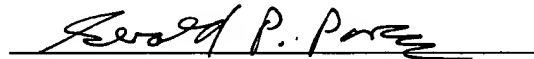
Supplemental Information Disclosure Statement

A Supplemental Information Disclosure Statement is being filed herewith to make a few additional references of record, and to correct the form PTO-1449 filed with the last responsive Amendment on October 9, 2003. That PTO-1449 incorrectly cited the two SD memory card specification documents that have now been reviewed by the Examiner. Replacement of those citations with the corrected citations on the form PTO-1449 being filed herewith is respectfully requested. Copies of these two references are not being resubmitted.

Conclusion

For the reasons stated above, it is believed that the present application is in condition for allowance and an early indication of its allowance is solicited. However, if there are any further matters that need attention or if any questions remain, the examiner is requested to telephone the undersigned attorney at 415-318-1163.

Respectfully submitted,


Gerald P. Parsons
Reg. No. 24,486

March 4, 2004
Date

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